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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,482	03/31/2000	Stephen J. Brown	014030.0126N2US	1136

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PATTON BOGGS LLP  
8484 WESTPARK DRIVE  
SUITE 900  
MCLEAN, VA 22102

EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/540,482

**Applicant(s)**

BROWN, STEPHEN J.

**Examiner**

Marc D. Thompson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 65-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20050401</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The amendment, received 4/1/2005, has been entered into record.
2. Claims 65-101 are now pending.

#### ***Priority***

3. This application is a continuation of Application 09/394,219, now U.S. Patent Number 6,375,469, which is a continuation of Application 08/814,293, now U.S. Patent Number 5,951,300.

4. The effective filing date for the subject matter defined in the pending claims in this application is 3/10/1997.

#### ***Drawings***

5. The examiner contends the drawings submitted on 11/17/2003 are acceptable for examination purposes.

#### ***Double Patenting***

6. In view of Applicant's submitted IDS, Applicant's outstanding, pending applications and issued patents, and the remainder of documents reviewed by Examiner, no double patenting rejections are deemed appropriate at this time. Applicant is advised to report any documents not currently before the Examiner which may contain subject matter including, minimally, the comparison of content of documents for display to a user, and any revision/modification of these documents in accordance with medical information available for the user.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 65-101 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goldman et al. (U.S. Patent Number 5,542,420), hereinafter referred to as Goldman, in view of Rapaport et al. (U.S. Patent Number 5,926,526), hereinafter referred to as Rapaport.

9. Goldman disclosed the analyzing and processing “health profiles” (inter alia, Column 2, Lines 16-20, Column 3, Lines 27-35) for generating individual personalized prescriptions (inter alia, Column 4, Lines 23-25). The integration of various types of networking equipment, including computers and telephony equipment to effect the inventive concept was expressly disclosed (inter alia, Column 4, Lines 16-33, Figure 2). The system operated to generate and output personalized prescriptions based on the contents of the current prescription, if present, and the health profile of the user. See, inter alia, Column 17, Lines 1-43. This iterative process provided a method for end users and health care professionals alike to refine a given set of suggested mandates for achieving optimal health in patients.

10. While Goldman disclosed the invention substantially as claimed, Goldman did not expressly disclose the replacing of elements in the output generated prescriptions. In general, Goldman generated the personalized prescriptions “from scratch”, essentially failing to use a template or other skeletal data form for information population, or information addition/deletion as currently claimed. It may be argued that Goldman did disclose a “preliminary compilation” of “certain basic nutrients or [] supplements” based on the health profile which was “processed utilizing a format of the disclosed

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embodiment” (Column 14, Lines 13-20), indicating the potential use for a template-type arrangement and subsequent population of a blank, incomplete, or inaccurate generated output.

11. Goldman specifically discussed the integration of various forms of technology, including telephones, computer networks, workstations, personal digital assistants (PDAs), facsimile machines, and other specialized equipment. See, *inter alia*, Figure 2. Any or all specifics of this functional integration was not specifically disclosed, thereby motivating one of ordinary skill in the art to look for teachings relating directly to the integration of these varying technologies in similar medical information and patient profile analysis systems.

12. In this same art of medical information assembly, user health profiles, and personalized message output generation based on user profiles, Rapaport specifically, disclosed the integration of various input and output devices, including telephones, facsimiles, video devices, televisions, wireless devices, “internet devices”, and electronic mail capable terminals in a very similar system. See, *inter alia*, Column 5, Lines 1-16. Like Goldman, the system functioned to output personalized messages to users based on stored profile information. See, *inter alia*, Column 8, Lines 14-26. The system specifically utilized codes corresponding to “prerecorded bulletin” segments which resulted in modification of a base document through substitution/replacement of these codes with message portions based on medical information in a user profile. See, *inter alia*, Column 10, Line 3 through Column 11, Lines 40.

13. In view of the teachings of Rapaport, the resulting modified system of Goldman would have been enabled to generate personalized medical prescription documents using

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a template populated with various document segments corresponding to associated codes, thereby providing the provision for comparison of the content in the document and replacement of at least a portion of the document with content in accordance with medical information relating to a user prior to display/rendering/delivery to the corresponding end user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the medical information profile and personalized message generator of Goldman with the medical information personalized message generator of Rapaport in order to enhance the Goldman system of prescription generation with an array of associated, relevant, message segments, directly pertinent to the end user patient (Goldman, inter alia, Column 17, Line 1 through Column 18, Line 7), by providing a variety of delivery devices/methods/formats to end user patients (Rapaport, inter alia, Column 3, Lines 20-21, Column 4, Lines 31-54, Column 5, Lines 11-16), and providing the ability to dynamically generate messages for end user patients based on health profile information (Rapaport, inter alia, Column 9, Line 40 through Column 12, Line 29).

14. All remaining limitations of the claimed invention are considered minimal, trivial, and likewise obvious to one of ordinary skill in the art. Thus, the resulting combination of these teachings and the knowledge available to one of ordinary skill in the art at the time the invention was made would have resulted in the system of the claimed invention.

15. Claims 65-101 are rejected.

#### ***Response to Arguments***

16. The arguments presented by Applicant in the response, received on 4/1/2005, are not considered persuasive.

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17. Applicant argues the claims contain limitation(s) directed to “filtering content based on a user profile containing medical information”, which is not taught or suggested by the prior art of record. See, Response, received 4/1/2005, Page 7, Last Paragraph. It is noted that this line of argument is not commensurate with the independently claimed invention, inter alia, in claim 1. The term “filtering” as known in the art at the time of invention typically indicated blocking or passage of particular information segments (usually messages or documents) through the filter. This functional behavior was common in regard to regulating access, transfer, or forwarding of the information being filtered. In contrary, Claim 1 describes “replacing” document content which is purely distinct from filtering. While it may be construed that the removal of portions of a document may broadly be considered filtering, the addition or replacement of content in the document itself, is above and beyond any minimally functional filter. Thus, the breadth of the arguments cannot be considered persuasive in regard to the prior art of record as applied.

18. It is noted that as a general matter, not only the specific teachings of a reference but also reasonable inferences which an artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. *In re Preda*, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and *In re Sherpard*, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. *In re Sovish*, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. *In re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or

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suggestion in a particular reference. *In re Bozek*, 416 F.2d 738, 1385 USPQ 545 (CCPA 1969) and *In re Nilssen*, 851 F.2d 1401-1403, 7 USPQ2d 1500-1502 (Fed. Cir. 1990).

Every reference relies to some extent on knowledge of persons skilled in the to complement that which is disclosed therein. *In re Bode*, 550 F.2d 656, 193 USPQ 545 (CCPA 1977).

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Review of this art is suggested, minimally, in view of MPEP §2123, while considering arguments and/or amendments to the claims.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-



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3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached at 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON  
MARC THOMPSON  
PRIMARY EXAMINER

Marc D. Thompson  
Primary Examiner  
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